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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/560,855	12/15/2005	Masaya Yamamoto	2005_1982A	2096

52349 7590 11/18/2011

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EXAMINER	
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ART UNIT	PAPER NUMBER
3621	

NOTIFICATION DATE	DELIVERY MODE
11/18/2011	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/560,855	YAMAMOTO ET AL.	
	Examiner	Art Unit	
	JACOB C. COPPOLA	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 January 2010*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on _____; the restriction requirement and election have been incorporated into this action.

4)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

5)☒ Claim(s) *6-14* is/are pending in the application.

5a) Of the above claim(s) _____ is/are withdrawn from consideration.

6)☐ Claim(s) _____ is/are allowed.

7)☒ Claim(s) *6-14* is/are rejected.

8)☐ Claim(s) _____ is/are objected to.

9)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

10)☒ The specification is objected to by the Examiner.

11)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

12)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☒ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *17 May 2010*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office Action has been withdrawn pursuant to 37 CFR 1.114. Applicants' submission filed on 12 January 2010 has been entered.

Acknowledgements

2. This Office Action is in reply to Applicants' response filed 12 January 2010 ("2010 January Response").

3. Claims 6-14 are currently pending and have been examined.

4. This Office Action is given Paper No. 20111114. This Paper No. is for reference purposes only.

Information Disclosure Statement

5. The Information Disclosure Statement filed on 17 May 2010 has been considered. An initialed copy of the Form 1449 is enclosed herewith.

Specification

6. The amendment filed 12 January 2010 ("2010 Specification Amendment") is acknowledged and hereby considered entered into the record.

7. The 2010 Specification Amendment is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

a. In paragraph [0019], the "For example, the contents reproduction method may include prohibiting, during the reproduction of the main resource, a start of reproducing a resource that is different from the main resource being reproduced and that requires license information for reproduction thereof, and may include permitting, during the reproduction of the sub resource, a start of reproducing a resource that is different from the sub resource being reproduced and that requires the license information for reproduction thereof;" and

b. In paragraph [0021], the "For example, the license management means may prohibit, during the reproduction of the main resource, a start of reproducing a resource that is different from the main resource being reproduced and that requires license information for reproduction thereof, and may permit, during the reproduction of the sub resource, a start of reproducing a resource that is different from the sub resource being reproduced and that requires the license information for reproduction thereof."

8. Applicants are required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC §112, First Paragraph

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 6-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

11. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Regarding Claim 6

12. Claim 6 recites "a step of (i) prohibiting, during said reproduction of the main resource, a start of reproducing a resource that is different from the main resource being reproduced and that requires the license information for reproduction thereof, and (ii) permitting, during said reproduction of the sub resource, a start of reproducing a resource that is different from the sub resource being reproduced and that requires the license information for reproduction thereof."

13. The Examiner has carefully reviewed Applicants' original disclosure and cannot locate an adequate description for the claimed features noted above. Additionally, the Examiner finds the features noted above are not inherent to the various components shown in the drawings.

14. Claim 8 recites similar features that cannot be found in the specification of the original disclosure. Accordingly, claim 8 is rejected in the same manner as claim 6.

Claim Rejections - 35 USC §112, Second Paragraph

15. The following is a quotation of the second paragraph of 35 U.S.C. §112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

16. Claims 6-14 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Regarding Claim 6

17. Claim 6 recites (emphasis added) "… a step of obtaining the content data, the content data including a plurality of resources, the plurality of resources including at least one main resource and including at least one sub resource, *the main resource, having license associated therewith that needs to be locked*, being data that includes a main part of contents, and *the sub resource*, which is a different entity from the main resource and *having a license associated therewith that does not need to be locked* …." Claim 6 is indefinite because it is unclear whether the "license" associated with the main resource and the "license" associated with the sub resource is obtained in the "step of obtaining the content data." For purposes of applying the prior art, the Examiner will assume that the "license" associated with the main resource and the "license" associated with the sub resource is not obtained in the "step of obtaining the content data."

18. Claim 6 further recites "… obtaining license information for the content data …." Claim 6 is further indefinite because it is unclear whether the "license information" is the same as the "license" associated with the main resource and the "license" associated with the sub resource.

Regarding Claim 8

19. Claim 8 recites (emphasis added) "… a contents storing memory that stores the content data that includes a plurality of resources, the plurality of resources including at least one main resource and including at least one sub resource, *the main resource, having a license associated therewith that needs to be locked*, being data that includes a main part of contents, and the *sub resource*, which is a different entity from the main resource *and having a license associated therewith that does not needs to be locked* …." Claim 8 is indefinite because it is unclear whether the "license" associated with the main resource and the "license" associated with the sub resource is stored in the "content storing memory." For purposes of applying the prior art, the Examiner will assume that the "license" associated with the main resource and the "license" associated with the sub resource is not stored in the "content storing memory."

20. Furthermore, claim 8 is indefinite because it is unclear how the structure of the "license" associated with the main resource and the "license" associated with the sub resource affects the *structure* of the "content storing memory."

21. Claim 8 further recites "… a license storing memory that stores license information for the content data, the license information being required for reproducing each of the main resource and the sub resource …." Claim 8 is further indefinite because it is unclear whether the

"license information" is the same as the "license" associated with the main resource and the "license" associated with the sub resource.

Regarding Claims 8-14

22. For the Non-Structural Phrases discussed below, the corresponding structure cannot be determined.

23. Particularly, claims 8-14 recite the limitation "license managing unit that…." It is self evident that this claim limitation does not use the phrase "means for" or "step for." However, the claim limitation uses a non-structural term, *i.e.* "license managing unit that," which is a term that is simply a substitute for "means for." Therefore, the Examiner will apply §112, ¶6 to the claim limitations that use the non-structural term associated with functional language. See USPTO Memorandum[1] by Bahr, Robert W., Supplementary Examination Guidelines for Determining Compliance with 35 U.S.C. § 112 and for Treatment of Related Issues in Patent Applications, [2] February 9, 2011; and Supplementary Examination Guidelines for Determining Compliance With 35 U.S.C. 112 and for Treatment of Related Issues in Patent Applications, Federal Register, Vol. 76, No. 27, 7162, January 21, 2011.[3]

24. In light of the above, the following claim phrases are limitations that invoke 35 U.S.C. §112, ¶6:

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[1] See MPEP §707.06 "Citation of Decisions, Orders Memorandums, and Notices" expressly authorizing examiners to cite to Commissioner's Memorandums which have not yet been incorporated into the MPEP.
[2] Available at http://www.uspto.gov/patents/law/exam/memoranda.jsp
[3] Available at http://www.gpo.gov/fdsys/pkg/FR-2011-02-09/pdf/2011-2841.pdf

c. In claim 8, the phrase "license managing unit that (i) prohibits, during the reproduction of the main resource by the reproducing unit, a start of reproducing a resource that is different from the main resource being reproduced and that requires the license information for reproduction thereof, and (ii) permits, during the reproduction of the sub resource by the reproducing unit, a start of reproducing a resource that is different from the sub resource being reproduced and that requires the license information for reproduction thereof."

25. For each claimed phrase that invokes 35 U.S.C. §112, ¶6, the written description fails to clearly link or associate the disclosed structure to the claimed function such that one of ordinary skill in the art would recognize what structure performs the claimed function.

26. For each claimed phrase that invokes 35 U.S.C. §112, ¶6, Applicants are required to either:

(a) Amend the claim so that the claim limitation will no longer be a non-structural term plus function limitation under 35 U.S.C. §112, ¶6; or

(b) Amend the written description of the specification such that it clearly links or associates the corresponding structure to the claimed function without introducing any new matter. See 35 U.S.C. 132(a).

27. For more information, see 37 C.F.R. § 1.75(d); MPEP §608.01(o); and MPEP §2181.

28. The Examiner finds that because the claims are indefinite under 35 U.S.C. §112, second paragraph, it is impossible to properly construe claim scope at this time. See *Honeywell International Inc. v. ITC*, 68 USPQ2d 1023, 1030 (Fed. Cir. 2003) ("Because the claims are indefinite, the claims, by definition, cannot be construed."). However, in accordance with MPEP §2173.06 and the USPTO's policy of trying to advance prosecution by providing art rejections

even though these claims are indefinite, the claims are construed and the prior art is applied as much as practically possible.

Claim Rejections - 35 USC §103

29. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

30. Claims 6, 8, 10, 11, and 13 are rejected under 35 U.S.C. §103(a) as being unpatentable over Candelore et al. (U.S. 2003/0174837 A1) ("Candelore"), in view of Abecassis (U.S. 6,289,165 B1).

Regarding Claim 6

31. Candelore discloses:

d. a step of obtaining content data ([0105] content is obtained by the "PID decoder/demultiplexer/descrambler circuit **614**"), the content data including a plurality of resources ([0105] "discrete channels of programming"), the plurality of resources including at least one main resource ([0115] "main program content") and including at least one sub resource ([0115] "one of a plurality of endings"), the main resource being data that includes a main part of contents, and the sub resource, which is a different entity from the main resource, being data that

is associated with the main resource and that includes related information associated with the main part of the contents (see at least [0113] [0115]);

e. a step of obtaining license information for the content data ([0108] license information, *e.g.*, a key, is obtained from the "Conditional Access Module" a.k.a. "CAM"), the license information being required for reproducing each of the main resource and the sub resource ([0031]-[0032] [0108]); and

f. a step of reproducing at least one of the main resource and the sub resource (see at least [0115], fig. 12).

32. Candelore does not directly disclose:

g. the main resource having a license associated therewith that needs to be locked;

h. the sub resource having a license associated therewith that does not needs to be locked; and

i. a step of (i) prohibiting, during said reproduction of the main resource, a start of reproducing a resource that is different from the main resource being reproduced, and (ii) permitting, during said reproduction of the sub resource, a start of reproducing a resource that is different from the sub resource being reproduced.

33. Abecassis teaches:

j. (i) prohibiting, during the reproduction of a main resource, a start of reproducing a resource that is different from the main resource being reproduced (see discussion of user video selections and billing, c. 40-41 – typically a user is prohibited from reproducing videos different from the ones purchased; see also "video-on-demand," at least c. 5), and (ii) permitting, during the reproduction of a sub resource (*e.g.*, content 3A of fig. 17C), a start of reproducing a resource

(*e.g.*, content 1A of fig. 17C) that is different from the sub resource being reproduced (fig. 17C shows, *e.g.*, switching between different camera angles).

34. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the system of Candelore with the functionality of the managing unit of Abecassis in order to seamlessly change between available sub resources.

35. Furthermore, with respect to the limitations "the main resource having a license associated therewith that needs to be locked" and "the sub resource having a license associated therewith that does not needs to be locked," the Examiner finds that these limitations do not structurally or functionally describe the claimed "contents reproduction device" of claim 8. Therefore, the limitations "the main resource having a license associated therewith that needs to be locked" and "the sub resource having a license associated therewith that does not needs to be locked" do not distinguish Applicants' invention over the prior art.

36. For purposes of the applying the prior art in the rejection above, the Examiner notes the following claim construction:

k. Claim 6 recites (emphasis added) "… (i) prohibiting, during the reproduction of the main resource by the reproducing unit, a start of reproducing a resource that is different from **the main resource** *being reproduced and that requires the license information for reproduction thereof*, …." The Examiner interprets the "being reproduced and that requires the license information for reproduction thereof" to be in reference to the "the main resource."

l. Claim 6 also recites (emphasis added) "… (ii) permitting, during the reproduction of the sub resource by the reproducing unit, a start of reproducing a resource that is different

from **the sub resource** *being reproduced and that requires the license information for reproduction thereof*." The Examiner interprets the "being reproduced and that requires the license information for reproduction thereof" to be in reference to the "the sub resource."

Regarding Claim 8

37. Candelore discloses:

m. a contents storing memory ([0105] *inherent* to the "PID decoder/demultiplexer/descrambler circuit **614**") that stores the content data that includes a plurality of resources ([0105] "discrete channels of programming"), the plurality of resources including at least one main resource ([0115] "main program content") and including at least one sub resource ([0115] "one of a plurality of endings"), the main resource being data that includes a main part of contents, and the sub resource, which is a different entity from the main resource, being data that is associated with the main resource and that includes related information associated with the main part of the contents (see at least [0113] [0115]);

n. a license storing memory ([0108] "Conditional Access Module" a.k.a. "CAM") that stores license information for the content data ([0108] *e.g.*, "key"), the license information being required for reproducing each of the main resource and the sub resource ([0031]-[0032] [0108]); and

o. a reproducing unit ("Set-top box **600**") that reproduces at least one of the main resource and the sub resource (see at least [0115], fig. 12).

38. Candelore does not directly disclose:

p. the main resource having a license associated therewith that needs to be locked;

q. the sub resource having a license associated therewith that does not needs to be locked; and

r. a license managing unit that (i) prohibits, during the reproduction of the main resource by the reproducing unit, a start of reproducing a resource that is different from the main resource being reproduced, and (ii) permits, during the reproduction of the sub resource by the reproducing unit, a start of reproducing a resource that is different from the sub resource being reproduced.

39. Abecassis teaches:

s. a license managing unit ("Multimedia Player **100**") that (i) prohibits, during the reproduction of a main resource by a reproducing unit, a start of reproducing a resource that is different from the main resource being reproduced (see discussion of user video selections and billing, c. 40-41 – typically a user is prohibited from reproducing videos different from the ones purchased; see also "video-on-demand," at least c. 5), and (ii) permits, during the reproduction of a sub resource (*e.g.*, content 3A of fig. 17C) by the reproducing unit, a start of reproducing a resource (*e.g.*, content 1A of fig. 17C) that is different from the sub resource being reproduced (fig. 17C shows, *e.g.*, switching between different camera angles).

40. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the system of Candelore with the functionality of the managing unit of Abecassis in order to seamlessly change between available sub resources.

41. Furthermore, with respect to the limitations "the main resource having a license associated therewith that needs to be locked" and "the sub resource having a license associated therewith that does not needs to be locked," the Examiner finds that these limitations do not

structurally or functionally describe the claimed "contents reproduction device" of claim 8. Therefore, the limitations "the main resource having a license associated therewith that needs to be locked" and "the sub resource having a license associated therewith that does not needs to be locked" do not distinguish Applicants' invention over the prior art.

42. For purposes of the applying the prior art in the rejection above, the Examiner notes the following claim construction:

t. Claim 8 recites (emphasis added) "… a license managing unit that (i) prohibits, during the reproduction of the main resource by the reproducing unit, a start of reproducing a resource that is different from **the main resource** *being reproduced and that requires the license information for reproduction thereof*, …." The Examiner interprets the "being reproduced and that requires the license information for reproduction thereof" to be in reference to the "the main resource."

u. Claim 8 also recites (emphasis added) "a license managing unit that … (ii) permits, during the reproduction of the sub resource by the reproducing unit, a start of reproducing a resource that is different from **the sub resource** *being reproduced and that requires the license information for reproduction thereof*." The Examiner interprets the "being reproduced and that requires the license information for reproduction thereof" to be in reference to the "the sub resource."

Regarding Claim 10

43. The combination of Candelore and Abecassis discloses the limitations of claim 8, as shown above, and further discloses:

the main resource includes a motion picture (Candelore, fig. 7 with associated text); and

the sub resource includes a still picture and does not include a motion picture (Candelore, fig. 7 with associated text).

Regarding Claim 11

44. The combination of Candelore and Abecassis discloses the limitations of claim 8, as shown above, and further discloses:

the-sub resource includes a plurality of still pictures that are associated with the main resource and that have been encrypted (Candelore, fig. 7 with associated text);

the contents reproduction device further comprises:

a decryption unit that decrypts the plurality of still pictures collectively to generate a plurality of decrypted still pictures (fig. 12 with associated text); and

a cache unit that stores the plurality of decrypted still pictures (fig. 12 with associated text); and

the reproducing unit, when reproducing the sub resource, reads one or more still pictures from the plurality of decrypted still pictures stored in the cache unit and reproduces the read one or more still pictures (Candelore, fig. 7 with associated text).

Regarding Claim 13

45. The combination of Candelore and Abecassis discloses the limitations of claim 8, as shown above, and further discloses:

the plurality of still pictures are collectively compressed, and the plurality of collectively compressed still pictures are encrypted (fig. 12 with associated text); and

the decryption unit decrypts the plurality of encrypted still pictures collectively to obtain the plurality of collectively compressed still pictures, and extracts the plurality of decrypted still pictures from the plurality of compressed still pictures (fig. 12 with associated text).

46. Claims 7, 9, and 14, as understood by the Examiner, are rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Candelore and Abecassis, in further view of Downs et al. (U.S. 6,226,618 B1) ("Downs").

Regarding Claim 7

47. The combination of Candelore and Abecassis discloses the limitations of claim 6, as shown above, and further discloses the limitations:

a step of permitting the start of reproducing the resource that has been prohibited by said prohibiting (see Abecassis' discussion of video user selections and billing, c. 40-41; see also "video-on-demand," at least c. 5).

48. Candelore does not directly disclose:

the license information includes use state information indicating a use state of the main resource; and

a step of updating the license information to reflect said reproduction of the main resource in the use state information included therein, the license information being updated when said reproduction of the main resource is finished.

49. Downs teaches:

license information that includes use state information ("watermark") indicating a use state of content data (c. 7, l. 40+); and

updating the license information to reflect reproduction of a main resource in the use state information included therein, the license information being updated when said reproduction of the main resource is finished (c. 7, l. 40+).

50. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to include with the license information of Candelore license information of Downs, which is dynamically updated, in order to allow per-use restrictions on the content of Candelore.

Regarding Claim 9

51. The combination of Candelore and Abecassis discloses the limitations of claim 8, as shown above, and further discloses the limitations:

the license managing unit permits the start of reproducing the resource that has been prohibited by the license managing unit (see Abecassis' discussion of video user selections and billing, c. 40-41; see also "video-on-demand," at least c. 5).

52. Candelore does not directly disclose:

the license information includes use state information indicating a use state of the content data; and

the license managing unit updates the license information to reflect the reproduction of the main resource in the use state information when the reproduction of the main resource is finished.

53. Downs teaches:

license information that includes use state information ("watermark") indicating a use state of content data (c. 7, l. 40+); and

a license managing unit ("End-User Player Application") that updates the license information to reflect the reproduction of a main resource in the use state information when the reproduction of the main resource is finished (c. 7, l. 40+).

54. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to include with the license information of Candelore license information of Downs, which is dynamically updated, in order to allow per-use restrictions on the content of Candelore.

Regarding Claim 14

55. The combination of Candelore and Abecassis discloses the limitations of claim 8, as shown above.

56. Candelore does not directly disclose:

the license information includes use state information indicating a use state of the content data;

the license managing unit updates the use state information based on a reproduction of each of the plurality of resources; and

when updating the use state information, the license managing unit does not update the use state information to reflect the reproduction of the sub resource.

57. Downs teaches:

the license information includes use state information indicating a use state of the content data (c. 7, l. 40+);

the license managing unit updates the use state information based on a reproduction of each of the plurality of resources (c. 7, l. 40+); and

when updating the use state information, the license managing unit does not update the use state information to reflect the reproduction of the sub resource (c. 7, l. 40+, watermark of Downs can be restricted to main resource – fig. 8 with associated text – watermark process executed before being sent to "control computer **300**" of Candelore; watermarked main resource combined with sub resource in "control computer 300" where both are encrypted and sent to STB).

58. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to include with the license information of Candelore the license information of Downs, which is dynamically updated, in order to allow per-use restrictions on the content of Candelore. Additionally, it would have been obvious to one of ordinary skill in the art, at the

time the invention was made, to only update said information for the main resource because the sub resources are often non-revenue based resources that do not require per use restrictions (*e.g.*, advertising data – Candelore, fig. 7 with associated text).

59. Claim 12 is rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Candelore and Abecassis, in further view of Admitted Prior Art ("APA").

Regarding Claim 12

60. The combination of Candelore and Abecassis discloses the limitations of claim 11 as shown above.

61. Candelore does not directly disclose wherein the decryption unit is tamper resistant.

62. However, APA discloses that tamper resistant units are old and well-known in the art because they deter hackers from reverse engineering secret algorithms and discovering hardware bound keys.

63. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the decryption unit of Candelore so that it is tamper resistant, as is old and well-known in the art, in order to deter hackers from reverse engineering secret algorithms and discovering hardware bound keys within the decryption unit.

Claim Interpretation

64. Unless expressly noted otherwise by the Examiner, the Examiner maintains his position on claim interpretation as noted in Paragraph No. 30, Paper No. 20081008.

65. The Examiner withdraws his position on claim interpretation as noted in Paragraph Nos. 27-29, Paper No. 20081008.

66. Unless expressly noted otherwise by the Examiner, the Examiner maintains his position on claim interpretation as noted in Paragraph Nos. 41 and 43, Paper No. 20091009.

67. The Examiner withdraws his position on claim interpretation as noted in Paragraph No. 42, Paper No. 20091009.

Response to Arguments

Priority Issues

68. Applicants argue "Therefore, for the same reasons discussed in the remarks submitted on May 7, 2009, the Applicants respectfully request that the Examiner acknowledge the claim of foreign priority and confirm receipt of the certified copy of the foreign priority document." 2010 January Response, page 9. The Examiner is unable to confirm receipt because the Office has not received the priority document.

69. Applicants' remarks submitted on 07 May 2009 state (emphasis added):

> Accordingly, the Applicant has made a proper claim of foreign priority, *and the Office should have received a certified copy of the foreign priority document*, in compliance with PCT Rule 17.2(a).
>
> Therefore, the Applicant respectfully requests that the Examiner acknowledge the Applicant's claim of foreign priority and confirm receipt of the certified copy of the foreign priority document.

70. As shown above, Applicants' argument is based on the premise that "the Office should have received a certified copy of the foreign priority document." The Examiner agrees that the Office *should* have a received a copy – unfortunately the Office has not.

Objection to the Specification

71. Applicants' 2010 Specification Amendment overcomes the previous objection (see Paper No. 20091009, ¶5).

35 U.S.C. §112, ¶1

72. Applicants argue:

> As mentioned above regarding the objection to the specification, the "prohibiting" and the "permitting" is described in paragraphs [0003] [0018], [0019], [0020], [0021], and [0045] of the specification.

2010 January Response, page 11.

73. The Examiner respectfully disagrees. While these portions appear to relate to locking a license, they do not support the limitations discussed above.

74. Additionally, Applicants argue:

> However, in order to avoid any further delay in the prosecution of the present application, paragraphs [0019] and [0021] have been amended to more clearly describe the above-mentioned limitations recited in claims 6 and 8.

2010 January Response, page 11.

75. The 2010 Specification Amendment to the specification does not overcome the 112, ¶1 rejection because the 2010 Specification Amendment is not part of the original disclosure.

Prior Art

76. Applicants appear to argue that Candelore does not disclose the claimed (emphasis in original) "… (i) the main resource (having a license associated therewith that needs to be locked)

includes a main part of contents, and (ii) the sub resource (which is a different entity from the main resource and has a license associated therewith that does not need to be locked) ...." 2010 January Response, page 13.

77. With respect to the "license" associated with the main resource and the "license" associated with the sub resource, this argument is not persuasive because the license is merely "associated therewith." Claim 6 does not require either license to be obtained in the "step of obtaining ..." and claim 8 does not require either license to be stored in the "contents storing memory." Therefore, Applicants are arguing claim limitations that are insufficient in distinguishing the invention over the prior art.

78. With respect to the "(i) the main resource ... includes a main part of contents, and (ii) the sub resource (which is a different entity from the main resource ...," this argument is not persuasive. Candelore gives a number of examples where the main resource includes a main part the sub resource is different than the main resource. See, *e.g.*, figure 7.

79. Additionally, Applicants argue (emphasis in original):

> Thus, in view of the above, it is clear that Abecassis merely teaches that videos can be electronically transmitted and that, based on a user changing their preference, different portions of the video will seamlessly begin playback at the appropriate points, but fails to disclose or suggest (i) prohibiting, during the reproduction of a main resource, a start of reproducing a resource that is different from the main resource being reproduced and that requires the license information for reproduction thereof, and (ii) permitting, during the reproduction of a sub resource, a start of reproducing a resource that is different from the sub resource being reproduced and that requires the license information for reproduction thereof, as recited in claim 6.

2010 January Response, page 14.

80. The Examiner respectfully disagrees. As discussed in columns 40-41, Abecassis teaches a user limited to portions of video that are purchased by the user (*i.e.*, prohibited from playing portions that are not paid for). This teaching meets the claimed "prohibiting, during the reproduction of a main resource, a start of reproducing a resource that is different from the main resource." Furthermore, as discussed in column 64, lines 32-61, Abecassis teaches permitting a user to switch between different camera angles of the same scene of a video. This teaching meets the claimed "permitting, during the reproduction of a sub resource, a start of reproducing a resource that is different from the sub resource being reproduced…."

81. Additionally, Applicants argue (emphasis in original):

> In other words, even though Abecassis teaches that different portions of a video can be accessed/reproduced based on a user changing their preference, Abecassis still fails to disclose or suggest the (i) prohibiting, during the reproduction of a main resource, a start of reproducing a resource that is different from the main resource being reproduced and that requires the license information for reproduction thereof, and (ii) permitting, during the reproduction of a sub resource, a start of reproducing a resource that is different from the sub resource being reproduced and that requires the license information for reproduction thereof, as required by claim 6.

2010 January Response, page 15.

82. This argument is not persuasive. Based on where Applicants have placed emphasis (as shown above via underlining), it appears that Applicants construct both instances of the claimed "requires the license information for reproduction thereof" to be in reference to the claimed "prohibiting" and the claimed "permitting," respectively. The Examiner's construction relied upon in the rejection is different. As shown above in the rejection, the Examiner constructs the first instance of "requires the license information for reproduction thereof" to be in reference to

the "main resource" and the second instance of "requires the license information for reproduction thereof" to be in reference to the "sub resource." Candelore meets the Examiner's construction of the claims. Therefore, the argument that Abecassis does not teach Applicants' construction of the claims is not persuasive.

Official Notice

83. Based upon a review of the 2010 January Response, the Examiner finds that Applicants did not traverse the Examiner's assertions of Official Notice as stated in the previous Office Action (see Paper No. 20091009, Paragraph No. 39). Because Applicants failed to traverse the Examiner's assertions of Official Notice as stated in the previous Office Action, the Examiner's assertions of Official Notice (indicating what is well known in the art) are taken to be admitted prior art ("Admitted Prior Art"). See MPEP §2144.03. *C.*

Conclusion

84. Applicants are respectfully reminded that any suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. To be especially clear, any suggestion or example provided in this Office Action (or in any future office action) does not constitute a formal requirement mandated by the Examiner.

v. Should Applicants decide to amend the claims, Applicants are also reminded that—like always—no new matter is allowed. The Examiner therefore leaves it up to Applicants

to choose the precise claim language of the amendment in order to ensure that the amended language complies with 35 U.S.C. § 112, ¶1.

w. Independent of the requirements under 35 U.S.C. § 112, ¶1, Applicants are also respectfully reminded that when amending a particular claim, all claim terms must have clear support or antecedent basis in the specification. See 37 C.F.R. § 1.75(d)(1) and MPEP § 608.01(o). Should Applicants amend the claims such that the claim language no longer has clear support or antecedent basis in the specification, an objection to the specification may result. Therefore, in these rare situations where the amended claim language does not have clear support or antecedent basis in the specification and to prevent a subsequent 'Objection to the Specification' in the next office action, Applicants are encouraged to either (1) re-evaluate the amendment and change the claim language so the claims do have clear support or antecedent basis or, (2) amend the specification to ensure that the claim language does have clear support or antecedent basis. See again MPEP § 608.01(o) (¶3). Should Applicants choose to amend the specification, Applicants are reminded that—like always—no new matter in the specification is allowed. See 35 U.S.C. § 132(a). If Applicants have any questions on this matter, Applicants are encouraged to contact the Examiner via the telephone number listed below.

85. The prior art made of record which is considered pertinent to Applicants' disclosure is listed on the document titled 'Notice of Reference Cited' ("PTO-892") Unless expressly noted otherwise by the Examiner, all documents listed on the PTO-892 are cited in their entirety.

86. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to Jacob C. Coppola whose telephone number is (571) 270-3922. The Examiner can normally be reached on

Monday-Friday, 9:00 a.m. - 5:00 p.m. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached at (571) 272-6779.

87. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, please contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

/JACOB C. COPPOLA/
Patent Examiner, Art Unit 3621
14 November 2011